



Mail Stop AF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Atty. Docket No.: 004770.00787
(NC29564US)

Christian Kraft

Serial No. 09/921,127

Examiner: Randy Peaches

Filed: August 3, 2001

Art Unit: 2686

For: A METHOD OF ENTERING
CHARACTERS INTO A TEXT
STRING AND A TEXT-EDITING
TERMINAL USING THE METHOD

Confirmation No. 6446

REQUEST TO WITHDRAW FINAL OFFICE ACTION

U.S. Patent and Trademark Office, **Mail Stop AF**
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the final office action mailed February 8, 2006, it is respectfully requested that the final office action be withdrawn and treated as a non-final office action.

Applicants thank Examiner Peaches for the courtesies extended to the undersigned during a teleconference on April 6, 2006. As agreed to during the teleconference, the office action was improperly designated as 'final' due to U.S. patent no. 5,953,541 to King et al. (King) and U.S. patent no. 6,528,741 to Walker (Walker) being applied as new grounds of rejection to claims 1 and 4-9, which were not necessitated by Applicant's amendment or based on information cited in a recently-submitted information disclosure statement. During the interview, Examiner Peaches requested that we treat the office action as 'non-final' and file a formal request to withdraw its final status.

The previous office action mailed March 28, 2005 rejected claims 1 and 4-9 under the judicially created doctrine of obviousness-type double patenting over claims of U.S. patent no.

6,810,272. The March 28, 2005 office action was the first action subsequent to a request for continued examination filed on February 28, 2005 (the RCE). No other grounds for rejection were provided in the March 28, 2005 office action. In response thereto, Applicant submitted a terminal disclaimer on August 29, 2005 that obviated all outstanding rejections.

Applicant did not amend the claims in the August 29, 2005 submission or provide an information disclosure statement that cited King or Walker. Note that King and Walker were of record and had previously been applied prior to the RCE. However, they were not applied in the first action since the RCE. Thus, they are presently being applied as a new ground of rejection that was neither necessitated by Applicant's amendment nor based on information submitted in an information disclosure statement. M.P.E.P. § 706.07(a) states, "Under present practice, second or any subsequent action on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement"

In addition, the office action appears to be non-responsive, as it is largely a verbatim copy of the office action mailed November 3, 2004, it fails to address the claim amendments and arguments pertaining to King and Walker provided in the after-final amendment filed on January 21, 2005 and requested to be considered via the RCE, and it fails to acknowledge the terminal disclaimer filed on August 29, 2005.

Accordingly, Applicant respectfully requests withdrawal of the final status of the outstanding office action mailed February 8, 2006.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: May 8, 2006

By:



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